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TFW
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Application of
Stewart E. Sloan
Serial No.: 10/827,032
Filed: April 19, 2004
Title: MESSAGE DEVICE
Group No.: 3764

BEFORE THE BOARD
OF PATENT APPEALS
AND INTERFERENCES

Appeal No. _____

APPELLANT'S APPEAL BRIEF

Commissioner for Patents
Alexandria, VA 22313

Dear Sir:

REAL PARTY IN INTEREST

The Appellant has not assigned his rights to any party; therefore, the real party in interest is Appellant.

RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences related to this case.

STATUS OF THE CLAIMS

This is an appeal of the Examiner's final rejection of claims 2-15. Claim 15 is an independent claim with claims 2-14 ultimately depending therefrom. Appellant believes that each of the claims is individually allowable and stands by itself.

STATUS OF AMENDMENTS

The Examiner entered a final rejection on May 16, 2005. In an effort to overcome the objection to the specification and the 35 U.S.C. § 112, second paragraph rejection, Appellant submitted an Amendment After Final Rejection. However, the Examiner refused to enter the Amendment on the grounds that the Amendment was not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal. Had the Examiner entered the Amendment After Final Rejection, the issues as to the objection to the specification and the rejection of the claims under 35 U.S.C. § 112, second paragraph, would have been moot and would have reduced the issues on appeal.

SUMMARY OF CLAIMED SUBJECT MATTER

Claim 15 is the only independent claim in the application with claims 2-14 ultimately depending therefrom. Claim 15 describes a massage device 10 for enabling a person sitting in a high back chair to massage his/her back. (Page 3, lines 5-6 and 14-25). Claim 15 further describes that the massage device comprises an elongated handle 12 including ends 14 and 16 with a ball 22 secured to the second end 16. (Page 3, lines 7-12 and Figs. 1, 2).

Claim 15 does not include any means-plus-function limitations pursuant to 35 U.S.C. § 112(6). Dependent claims 2-14 likewise do not contain any means-plus-function limitations pursuant to 35 U.S.C. § 112(6).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(0). Correction of the following is required: There is no support in the specification for the ball being removably mounted or the hand-gripping portion being generally V-shaped.

Claims 2-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention.

In claims 2-15, the preamble recites that the claims are combination claims. However, there is no combination recited in the bodies of the claims.

Claims 3-4, 6, 8, 11 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Haygood.

Haygood discloses in figures 1-9 a batting practice device that anticipates a combination massage device comprising an elongated handle (4, 12), that has a hand gripping portion (the opening in 4), a ball 24 that is resilient (col. 4, lines 31-34) and removably attached to the handle (via 26) and the hand-gripping portion is generally V-shaped (fig. 1).

Claims 2 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haygood in view of Mitchell

Haygood discloses in figures 1-9 a batting practice device that anticipates a combination massage device, substantially as claimed. However, Haygood does not disclose the handle being flexible or made of plastic. Mitchell teaches in figures 1-8 a

1 flexible handle 14 having a resilient ball 12 attached at one end (fig. 1). The handle is
made of plastic (col. 4, lines 38-41). It would have been obvious to one having
ordinary skill in the art at the time that the invention was made that the handle
disclosed by Haygood could be completely flexible as taught by Mitchell in order to
5 allow the handle to wrap around the user's hand. The handle could be made of plastic
because it is durable material that would allow the device to extend downward in order
to use the ball as a massaging device on any portion of the human body.

Claims 7 and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable
10 over Haygood in view of Rodriguez.

Haygood discloses in figures 1-9 a batting practice device that anticipates a
combination massaging device, substantially as claimed. However, Haygood does not
disclose the ball being a tennis ball or a net extending around the ball. Rodriguez
teaches in figures 1-2 a tennis volley practice device comprising a ball (col. 4, lines 40-
15 42) inside of a net 10, wherein the net and the ball are attached to a handle 1. It would
have been obvious to one having ordinary skill in the art at the time that the invention
was made that the tennis ball as taught by Rodriguez could be substituted for the ball
disclosed by Haygood because either ball could be used to massage portions of the
20 human body. The net material as taught by Rodriguez could be used to assist in
holding the ball onto the handle.

Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over
Haygood in view of Mitchell, along with Killion.

1 Haygood discloses in figures 1-9 a batting practice device that anticipates a
combination massage device, substantially as claimed. However, Haygood does not
disclose the handle being flat, flexible and made of plastic. Mitchell teaches in figures
1-9 a flexible handle 16 made of plastic. Killion teaches in figure 1 a handle that is flat.
5 It would have been obvious to one having ordinary skill in the art at the time that the
invention was made that the handle disclosed by Haygood could be flexible and made
of plastic as taught by Mitchell for the reason set forth above. The handle could be flat
as taught by Killion because flatness is simply a different shape that doesn't provide
any novelty over the prior art.
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ARGUMENT

(A) Whether the specification fails to provide proper antecedent basis for the
claimed subject matter.

15 The Examiner objected to the specification on the grounds that there was no
support in the specification for the ball being removably mounted or the hand-gripping
portion being generally V-shaped. Appellant does not understand the Examiner's
objection with respect to the ball being removably mounted inasmuch as none of the
claims recite that limitation. Accordingly, the Examiner's objection with respect to the
20 ball being removably mounted is not proper.

With respect to the Examiner's objection to the specification not providing
proper antecedent basis for the fact that the hand-gripping portion is generally
V-shaped, original claim 11 described that the hand-gripping portion is generally
V-shaped. Inasmuch as the original claims form a part of the specification, the
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1 Examiner's objection that the specification does not describe a hand-gripping portion
being generally V-shaped is without merit.

(B) Whether claims 2-15 are indefinite under 35 U.S.C. § 112.

5 In the 35 U.S.C. § 112, second paragraph, rejection with respect to claims 2-15,
the Examiner stated the preamble recites that the claims are combination claims but
there is no combination recited in the bodies of the claims.

10 Appellant believes that the claims are properly termed combination claims since
they describe the combination of the elongated handle and a ball secured to the
second end of the handle. The original claims were not combination claims, but were
directed to a massage device as set forth in the preamble of original claim 1. Claims
2-14 ultimately depended from claim 1 and recited the term "massage device." The
original claims were then amended to eliminate the term "massage device" in the
preamble with the word "combination" substituted therefore. If the Examiner had
15 entered the Amendment After Final Rejection, this issue would not be present in the
case. In the event that the Board reverses the final rejection of the Examiner,
Appellant is willing to change the preamble of the claims to recite "massage device"
rather than "combination."

20 (C) Whether claims 3-4, 6, 8, 11 and 15 are patentable over Haygood pursuant
to 35 U.S.C. § 102(b).

25 In the final rejection, the Examiner takes the position that Haygood discloses a
batting practice device that anticipates a massage device comprising an elongated
handle (4, 12). The Examiner also stated that claim 15, and all of the claims

1 depending therefrom, describes that Appellant's handle is elongated. The Examiner
believes that Haygood discloses that element 4 is the handle which is connected to a
rope 12 by members 6, 8 and 10. Thus, the oval-shaped handle 4 of Haygood is not
elongated and Haygood cannot anticipate claims 3-4, 6, 8, 11 and 15. Accordingly,
5 the Examiner's rejection under 35 U.S.C. § 102(b) must fail.

(D) Whether claims 2 and 5 are patentable over Haygood in view of Mitchell
under 35 U.S.C. § 103(a).

10 In the final rejection of claims 2 and 5, the Examiner contends that Haygood
discloses in Figs. 1-9 a batting practice device that anticipates a combination massage
device, but recognizes that Haygood does not disclose that the handle is flexible or
made of plastic. The Examiner contends that Mitchell teaches in Figs. 1-8 a flexible
handle 14 having a resilient ball 12 attached at one end (Fig. 1) and that the handle is
made of plastic (Col. 4, lines 38-41). The Examiner concluded that it would have been
15 obvious to one having ordinary skill in the art at the time that the invention was made
that the handle disclosed by Haygood could be completely flexible, as taught by
Mitchell, in order to allow the handle to wrap around the user's hand.

20 It is contended that Mitchell is non-analogous art and that it relates to a toy
while Appellant's invention relates to a massage device. A person working in the
massage device field would not look to the non-analogous toy art disclosed in the
Mitchell patent.

25 Whether a reference in the prior art is analogous is a fact question. Two criteria
are used: (1) whether the art is from the same field of endeavor, regardless of the

1 problem addressed; and (2) if the reference is not within the field of the inventor's
endeavor, whether it still is reasonably pertinent to the particular problems with which
the inventor is involved. If a reference disclosure has the same purpose as the
claimed invention, the reference relates to the same problem, and that fact supports
5 use of the reference to determine obviousness. If it is directed to a different purpose,
the inventor would accordingly have had less motivation or occasion to consider it. In
re Clay, 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992). It is submitted that if the
Haygood and Mitchell references are not within the field of the Appellant's endeavor, a
10 massage device, the fact finder must then look at whether the field of the reference is
reasonably pertinent to that problem. In re GPAC, Inc., 57 F.2d 1573, 35 USPQ2d
1116 (Fed. Cir. 1995). Of course, difficulties can arise in making the determination of
what is pertinent or not. Hindsight selection of the pertinent art must be avoided at all
cost. Union Carbide Corp. v. American Can Co., 724 F.2d 1567, 220 USPQ 584 (Fed.
15 Cir. 1984).

Appellant alleges that a person working in the massage device art would not
look to the toy art such as disclosed in Mitchell.

In determining the differences between the prior art and the claims, the question
20 under 35 U.S.C. § 103 is not whether the differences themselves would have been
obvious, but whether the claimed invention as a whole would have been obvious.
Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). A
prior art reference must be considered in its entirety, *i.e.*, as a whole, including
25 portions that would lead away from the claimed invention. W.L. Gore & Associates,

1 Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983). Distilling an
invention down to the "gist" or "thrust" of an invention disregards the requirement of
analyzing the subject matter "as a whole". Id. Impermissible hindsight must be
avoided and the legal conclusion must be reached on the basis of the facts claimed
5 from the prior art. MPEP § 2142.

The prior art must suggest the desirability of the claimed invention. There are
three possible sources for a motivation to combine or modify a reference: the nature of
the problem to be solved, the teachings of the prior art, and the knowledge of persons
of ordinary skill in the art. In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453,
10 1457-58 (Fed. Cir. 1998) (stating that the combination of references taught every
element of the claimed invention, however without a motivation to combine, a rejection
based on a *prima facie* case of obviousness was held improper). Furthermore, the
fact that references can be combined or modified is not sufficient to establish *prima*
15 *facie* obviousness. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).
(Emphasis provided). Although a prior art device "may be capable of being modified to
run the way the apparatus is claimed, there must be some suggestion or motivation in
the reference to do so." Id. Also, a statement that "modifications of the prior art meet
20 the claimed invention would have been 'well within the ordinary skill of the art at the
time the invention was made because the references relied upon teach that all aspects
of the claimed invention were individually known in the art' is not sufficient to establish
a *prima facie* case of obviousness without some objective reason to combine or modify
the teachings of the references." Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat.

1 App. & Inter. 1993); see also, In re Kotzob, 217 F.3d 1365, 1371, 55 USPQ2d 1313,
1318 (Fed. Cir. 2000) (the court reversed an obviousness rejection involving a
technologically simple concept because there was no finding as to the principle or
specific understanding within the knowledge of a skilled artisan that would have
5 motivated the skilled artisan to make the claimed invention).

Appellant asserts that there is no suggestion or motivation whatsoever to
modify the prior art as the Examiner has proposed.

Moreover, to establish *prima facie* obviousness of a claimed invention, all of the
10 claimed limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d
981, 180 USPQ 580 (CCPA 1974). All words in the claim must be considered in
judging the patentability of the claim against the prior art. In re Wilson, 424 F.2d 1382,
1385, 165 USPQ 494, 496 (CCPA 1970). Appellant asserts that the Examiner has
failed to consider all of the words of the claims.

15 It is therefore submitted that inasmuch as there is no suggestion, motivation or
teaching that the prior art devices such as disclosed in Haygood and Mitchell could be
combined, much less used as a massage device, claims 2 and 5 are patentable over
Haygood in view of Mitchell.

20 (E) Whether claims 7 and 9-10 are patentable over Haygood in view of
Rodriguez under 35 U.S.C. § 103(a).

In the rejection of claims 7 and 9-10, the Examiner again relies on Haygood, but
does recognize that Haygood does not disclose the ball being a tennis ball or having a
net extending around the ball. The Examiner contends that Rodriguez teaches in Figs.
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1-2 a tennis volley practice device wherein the net and the ball are attached to a handle. The Examiner concluded that it would have been obvious to one having ordinary skill in the art at the time that the invention was made that the tennis ball, as taught by Rodriguez, could be substituted for the ball disclosed by Haygood because either ball could be used to massage portions of the human body.

Appellant contends that claims 7 and 9-10 are patentable for the reasons expressed in support of claim 15 hereinabove. Further, Appellant contends that the Haygood and Rodriguez prior art devices relate to non-analogous art as discussed above. The Rodriguez device is a practice device used in the tennis field while Haygood relates to a batting practice device. It would have not been obvious to a person having ordinary skill in the massage device art to combine the teachings of Haygood and Rodriguez. Therefore, the Examiner's final rejection of claims 2 and 5 should be reversed.

(F) Whether claims 12-14 are patentable over Haygood in view of Mitchell, along with Killion, under 35 U.S.C. § 103(a).

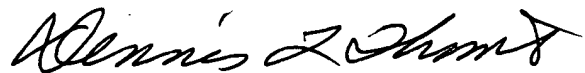
In the rejection of claims 12-14, the Examiner continues to rely on Haygood. Appellant relies upon the argument set forth hereinabove relating to the Haygood reference as well as the non-analogous art argument made by Appellant hereinabove.

First, the connecting element of Killion is not substantially flat, as required by claim 12. Even if the three references of record were combined, the resulting structure still would not correspond to Appellant's claimed structure. It simply would not have been obvious to combine the teachings of the prior art as suggested by the Examiner.

1 Even if the same were obvious, it would not be obvious to utilize the device as a
message device. There is absolutely no suggestion whatsoever in the prior art that
the devices disclosed therein and relied upon by the Examiner could be used as a
message device for a person sitting in a high back chair, as required by all of the
5 claims. Therefore, the final rejection of claims 12-14 should be reversed.

The foregoing has clearly shown that claims 2-15 are patentable. It is believed
that each of claims 2-14, which ultimately depend from claim 15, are also separately
allowable.

10 Respectfully submitted,



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